

REMARKS

As a preliminary matter, Applicants thank the Examiner for the courtesy extended to Applicants' representative, Josh C. Snider, in the telephone interview conducted September 17, 2003, between the Examiner and Mr. Snider. The finality of the outstanding Office Action was discussed, along with claims 1, 8, 15, and 18-19. Agreement was only reached with respect to claim 15, which is herein cancelled without prejudice.

As a second preliminary matter, Applicants specifically traverse the finality of the present Office Action (Paper No. 20). The present outstanding Office Action is in response to a timely filed Request for Continuing Examination ("RCE"), and proper submission (Amendment D), which were both filed on April 2, 2003. The Examiner's decision therefore, to make the first Office Action final after filing the RCE, is contrary to the clear conditions set forth in the MPEP. The amended claims in Amendment D are not drawn to the same invention as the previous Application.

The finality of the Office Action is inappropriate because "key data" is not the same as "random key data," as the claims in Amendment D were amended to now recite. The substantive narrowing amendment from "key data" to "random key data" is neither insubstantial nor immaterial, nor is it merely a "colorable variation" of the same invention, which is the standard laid out in the MPEP for determining whether two claims may be drawn to the same invention. In the present case, this standard has not been met.

The Examiner has even acknowledged as much in the telephone interview of September 17, 2003. The Examiner stated in the interview that, in this specific field of art, making key data non-random adds very little to an invention, and creates a security system that is easy to defeat. Even if, for the purposes of this discussion, these assertions by the Examiner were correct, a "very little" difference between two claims is still some difference, and the two claims would be patentably distinct from one another were they to be otherwise allowable. The simplicity and/or size of an invention are not standards recognized in patent law on which to reject claims as drawn to the same invention.

The April 2, 2003 RCE was filed together with Amendment D as a courtesy to the Examiner, to allow him additional time to consider the amendments and arguments presented, and to avoid any unnecessary effort and delay involved to issue an Advisory Action. Applicants were not required to file the RCE with Amendment D, and could have required the Examiner to first file some response to Amendment D before the RCE would have been necessary. As a matter of policy therefore, the Examiner's decision to make this first Office Action final is inappropriate because it encourages Applicants to delay requests for continued examination as long as possible, in order to require an additional response from the Examiner, and usually in the form of an unnecessary Advisory Action. As a matter of policy, the finality of the outstanding Office Action should be withdrawn to discourage excessive prosecution after prosecution on the merits should be closed.

As a third preliminary matter, Applicants respectfully traverse the outstanding Office Action as being not fully responsive. Section 707.07(f) of the MPEP places the burden upon the Examiner, where the Applicants traverse any rejection, to take note of all of Applicants arguments, and answer the substance of those arguments when the rejection is repeated. In the present case, however, the Examiner has not done so.

Specifically, Applicants presented meritorious arguments in Amendment D directed toward how neither the Kaufman (U.S. 6,178,508) nor Ganesan (U.S. 5,748,508) reference, alone or in combination, taught or suggested the step of generating different key data for each of a plurality of unit storage areas on the storage medium. Amendment D also presented arguments how neither of the two prior art references addressed protection of the data on the storage medium itself, as opposed to the user *access* to such data on the medium. The Examiner has not fully answered these meritorious arguments, all of which sufficiently rebut the *prima facie* case of obviousness, and would thus render the claims of the present invention as patentably distinct over the prior art. Accordingly, all of the arguments presented on pages 10 through 13 of Amendment D are incorporated by reference herein, and for at least for these additional reasons, the outstanding Office Action should be vacated.

Claim 15 stands rejected under 35 U.S.C. 101 as directed to non-statutory subject matter. Claim 15 has been cancelled, rendering this rejection now moot.

Claims 1, 6-8, and 13-19 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ganesan in view of Kaufman. Applicants respectfully traverse this

rejection for the reasons of record. Applicants respectfully request that the Examiner reconsider the arguments presented in Amendment D, and withdraw this Section 103 rejection. Additionally, Applicants respectfully request that the Examiner consider the following new arguments and expansions upon the previous arguments.

The Examiner's assertion on page 3 of Paper No. 20, that Applicants argued that "both Ganesan and Kaufman teach password encryption," mischaracterizes what Applicants actually argued in Amendment D. Applicants did not argue that the two references teach "password encryption," but instead argued that the two references teach "direct password encryption." The focus of Applicants' arguments was therefore directed to the fact that the storage medium of the present invention is encrypted separately with generated random key data, and not to the fact of a direct password (or public key) as the encryption key, which is taught by both Ganesan and Kaufman.

The difference between the present invention and the two cited references is not therefore an issue of whether or not a public key may function as a password, but instead one of how both the password and public key fail to encrypt generated random key data separately. The Examiner has still not fully responded to these meritorious arguments from Amendment D. Furthermore, the Examiner himself has even acknowledged, on pages 5 and 6 of Paper No. 20, that the private key (as taught by Ganesan) operates as a password as applied to this discussion. For at least these reasons, the rejection based on a combination of Ganesan and Kaufman should be withdrawn.

Additionally, Applicants wish to correct the Examiner's characterization of the recited claim language of the present invention, as well as other arguments presented in Amendment D directed toward features of the present invention that address the generation of different random key data for each of a plurality of unit storage areas of the storage medium, and the encryption of each of the different random key data for each unit storage area with a password. The Examiner's remarks in this regard, that "generating a key for a storage area fails to convey that the key is tied specifically to that storage area," are contrary to the express language of the claims of the present invention. The claims clearly recite that different random key data is generated for each of a plurality of storage areas on a storage medium, and that different random key data generated for each unit storage area is encrypted with a password. The plain reading of the claim language itself clearly shows that each storage area has a different specific random key data, therefore each storage area is defined to be "tied" at least one unique key. Accordingly, the Examiner's comments on page 3 of Paper No. 20 should be reconsidered, and the Section 103 rejection should be withdrawn for at least these additional reasons.

As a separate issue, Applicants do not understand the Examiner's comments on page 4 of Paper No. 20 (paragraph 4), asserting that Applicants have relied upon "symmetric keys assigned to storage areas prior to encryption" as features of the present invention. Applicants have made no such arguments. The only discussion of symmetric keys in Amendment D was directed toward a discussion of the Ganesan

reference itself, and not toward the features of the present invention. Applicants therefore respectfully request that the Examiner clarify his remarks on this issue.

As explained above, a *prima facie* case of obviousness has not been established against the present invention. Moreover, Applicants' additional rebuttal arguments, directed toward the specific advantages the present invention realizes over both prior art references, were sufficient to overcome even such a *prima facie* case, and have not been challenged or fully answered. Such advantages are to be considered by the Examiner as an appropriate rebuttal, once a *prima facie* case of obviousness could be established. In the present case, the advantages of the present invention over the prior art of record remain unchallenged.

As previously, discussed both Ganesan and Kaufman are specifically drawn towards systems which protect access to a database, as well as the passwords of individual users to access such a database. Neither reference, alone or in combination, addresses or solves the problem of protecting the user-accessed data on the database itself. Access to the data, by a user, is different than the data which is actually accessed by the user. Similarly, protecting such user access is not the same as protecting the data. These advantages of the present invention remain undisputed in the record, and are by themselves sufficient to rebut the Examiner's proposed combination of Ganesan and Kaufman to reach the present invention. Accordingly, for at least these reasons as well, the Section 103 rejection based on Ganesan and Kaufman is once again respectfully traversed, and should be withdrawn.

Claims 2 and 9 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ganesan and Kaufman, and further in view of Cruts et al. (U.S. 4,780,905). Claims 3-4 and 10-11 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ganesan and Kaufman, and further in view of Schneier ("Applied Cryptography"). Claims 5 and 12 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ganesan and Kaufman, and further in view of Blakley et al. (U.S. 5,677,952). Applicants respectfully traverse all three rejections for at least the reasons discussed above. All of these rejected claims depend either directly or indirectly from either of independent claims 1 and 8, and therefore include all the features of their respective base claims, plus additional features. Accordingly, the rejection of these dependent claims is traversed for at least the reasons discussed above in traversing the rejection of independent claims 1 and 8 based on the Ganesan and Kaufman references only.

For all of the foregoing reasons, Applicants submit that this Application, including claims 1-14 and 16-19, is in condition for allowance, which is respectfully requested. The Examiner is invited to contact the undersigned attorney if an interview would expedite prosecution.

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